

## REMARKS

### *The Pending Claims*

Claims 1-10 are currently pending. Claims 1-8 are directed to a negative-working heat-sensitive material for making a lithographic printing plate by direct-to-plate recording. Claims 9-10 are directed to a direct-to-plate method of making a lithographic printing plate. Reconsideration of the claims is respectfully requested.

### *Summary of the Office Action*

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 1, 4-7, 9, and 10 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by WO 99 19143 (hereinafter "DeBoer"). Claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over DeBoer in view of U.S. Patent 6,399,276 (hereinafter "Van Damme et al.").

### *The Amendments to the Claims*

The claims have been amended so as to more particularly point out and distinctly claim the subject matter of the invention. In particular, claim 2 has been amended to recite that the organic compound is derived from poly(styrene sulfonic acid) or a salt thereof or poly(vinyl phosphonic acid) or a salt thereof. Moreover, claims 5 and 6 have been amended to correct obvious grammatical errors. No new matter has been added by way of these amendments. Separate documents setting forth the precise changes to the claims and the text of the pending claims as amended are attached hereto.

### *Discussion of the Section 112, Second Paragraph, Rejection*

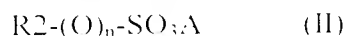
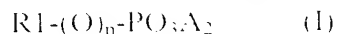
The Office Action rejects claim 2 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. According to the Office Action, "it is unclear what is meant by 'derived'" (Office Action, page 2).

Claim 2 has been amended to recite that the organic compound is derived from poly(styrene sulfonic acid) or a salt thereof. In view of the amendment to claim 2, the rejection under Section 112, second paragraph, is believed to be moot and should be withdrawn.

*Discussion of the Anticipation Rejection*

The Office Action rejects claims 1, 4-7, 9, and 10 under 35 U.S.C. § 102(b) as allegedly anticipated by DeBoer. Applicants respectfully traverse the Section 102(b) rejection for the reasons set forth below.

Referring first to claim 1 and claims 4-7 (which depend from claim 1), those claims are directed to a negative-working heat sensitive material for making a lithographic printing plate by direct-to-plate recording. The material comprises in the order given a lithographic base having a hydrophilic surface, an oleophilic imaging layer, and a cross-linked hydrophilic upper layer, characterized in that the cross-linked hydrophilic upper layer comprises an organic compound corresponding to one of the following formula:



wherein n is 0 or 1, A is hydrogen, a counter ion or an alkyl group, R1 is an organic radical, and R2 is a macromolecular organic radical. DeBoer, however, does not teach or suggest a material comprising a cross-linked hydrophilic upper layer comprising an organic compound as recited in claim 1 (and all claims dependent thereon). Thus, DeBoer does not disclose all the features of claims 1 and 4-7, and cannot be said to anticipate those claims.

As regards claim 9 and claim 10 (which depends from claim 9), those claims are directed to a direct-to-plate method of making a lithographic printing plate that comprises, *inter alia*, providing a material according to any of the preceding claims (i.e., a material according to any of claims 1-8). As discussed above, DeBoer fails to teach or suggest the material recited in claim 1 and all claims dependent thereon. Thus DeBoer does not disclose all the features of claims 9-10, and cannot be said to anticipate those claims. Indeed, there is no teaching or suggestion in DeBoer of the present inventive method.

In support of its position, the Office states the following:

In Example 5, a grained and anodized aluminum support was coated with a photothermal layer and a crosslinked layer comprising a carbon dispersion wherein the carbon is modified with sulfonic acid at the surface. The sulfonic acid surface modified carbon meets the present limitations for the organic compound for formula II. The top layer meets the present limitations for the crosslinked upper layer. (Office Action, page 3)

Applicants respectfully disagree with the Office's position. One of ordinary skill in the art would readily appreciate that DeBoer does not teach or suggest an organic compound of formula II as recited in claim 1. In particular, one of ordinary skill in the art would readily appreciate that the carbon discussed in DeBoer does not constitute a macromolecular organic

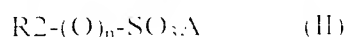
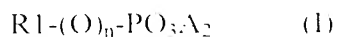
radical. Notably, DeBoer does not characterize carbon as a macromolecular organic radical. Rather, DeBoer characterizes carbon as a pigment (see page 9, lines 15-16, of DeBoer). While molecules in a macromolecule are covalently bonded to each other, molecules in a pigment are not covalently bonded to each other. Furthermore, carbon black is not defined as an organic compound, but as an element (see page 659 of HACH'S CHEMICAL DICTIONARY, 3<sup>rd</sup> Ed., McGraw-Hill Book Company, Inc. (1944), which is attached hereto).

Since DeBoer fails to disclose each and every feature of the negative-working heat-sensitive material recited in claim 1, it cannot be said that it anticipates claim 1 and all claims dependent thereon (including claims 1, 4-7, 9, and 10). Accordingly, the anticipation rejection under Section 102(b) is improper and should be withdrawn.

#### *Discussion of the Obviousness Rejection*

The Office Action rejects claims 3 and 8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over DeBoer in view of Van Damme et al. Applicants respectfully traverse the Section 103(a) rejection for the reasons set forth below.

Claims 3 and 8 depend from claim 1. As discussed above, DeBoer does not teach or suggest a negative-working heat sensitive material for making a lithographic printing plate by direct-to-plate recording as recited in claim 1. Accordingly, it cannot be said that DeBoer discloses or suggests all of the features of claims 3 and 8. Indeed, there is no teaching or suggestion in DeBoer of a material comprising in the order given a lithographic base having a hydrophilic surface, an oleophilic imaging layer, and a cross-linked hydrophilic upper layer, characterized in that the cross-linked hydrophilic upper layer comprises an organic compound corresponding to one of the following formula:



wherein n is 0 or 1; A is hydrogen, a counter ion or an alkyl group; R1 is an organic radical; and R2 is a macromolecular organic radical, much less a teaching or suggestion of such a material wherein the oleophilic imaging layer has a dry coating weight between 0.1 and 0.75 g m<sup>2</sup> (as recited in claim 3) or wherein the cross-linked hydrophilic upper layer has a dry thickness between 0.3 and 5 µm (as recited in claim 8).

In support of its position, the Office relies on Van Damme et al. At best, Van Damme et al. is prior art under 35 U.S.C. § 102(e). However, Van Damme et al. is commonly owned with the present application. Accordingly, Van Damme et al. may not be used to set forth an obviousness rejection under 35 U.S.C. § 103(a). See 35 U.S.C. § 103(e).

In view of the foregoing, the obviousness rejection with respect to claims 3 and 8 is improper and should be withdrawn.

In re Appln. of Van Damme et al.  
Application No. 10 002,944

*Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

Salim A. Hasan, Reg. No. 38,175  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: March 12, 2003

In re Appln. of Van Damme et al.  
Application No. 10 002,944

CERTIFICATE OF MAILING

I hereby certify that this AMENDMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date:

3/12/03

Virginia Scheffe